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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,658	04/02/2004	Shinichiro Iwata	K2635.0078	8203

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EXAMINER	
NGUYEN, CHAU T	

ART UNIT	PAPER NUMBER
2176	

DATE MAILED: 07/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/815,658	IWATA, SHINICHIRO	
	Examiner	Art Unit	
	Chau Nguyen	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 April 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☒ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 04/02/2004
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 16 are presented for examination.

Information Disclosure Statement

2. The information disclosure statement filed 04/02/2004 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29

USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-6 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,839,877 (Iwata). Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-6 of the instant application is anticipated by patent claims 1-6 in that claims 1-6 of the patent contains all the limitations of claim 1 of the instant application. Therefore, claims 1-6 of the instant application is not patently distinct from the earlier patent claim and as such is unpatentable for obvious-type double patenting.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumoto, JP Patent No. JP 11328181 A, Hayashi, JP Patent No. JP 10222501 A further in view of Moughanni et at. (Moughanni), US Patent No. 5,675,817.

7. As to independent claim 1, Matsumoto discloses a method of displaying an electronic message, comprising: receiving an electronic message including a sentence as a conversion object sentence in a reception mode (Matsumoto, pages 1-2: a sentence is inputted for translation; automatically converts each of character string to produce a mixed sentence; and displaying said mixed sentence (KANA/KANJI conversion is performed and the inputted sentence is turned to a KANJI/KANA mixed sentence, and the mixed sentence is displayed). However, Matsumoto does not disclose the mixed sentence is pictograph mixed sentence and the pictograph corresponding to said character string is defined. Hayashi discloses an animation database stores the data of animation image about a character, retrieving a character that is inputted with a conversion operation, then converting it into a corresponding

candidate character into an animation image (pictograph mixed sentence) (Hayashi, page 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Hayashi and Matsumoto to include pictograph mixed sentence and the pictograph corresponding to said character string is defined since Hayashi provides a character converter which does not only simply perform character conversion but also has various conversion functions.

However, Matsumoto and Hayashi do not explicitly disclose the electronic message is an electronic mail. Moughanni discloses a user of a pager receiving an electronic message (electronic mail) in a language of their own and the message (mail) is translated to a default language of the user (Abstract). Since Moughanni discloses translating or converting a language to a different one, which is similar to language conversions of Matsumoto and Hayashi, thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Moughanni and Matsumoto and Hayashi to include an electronic mail as an input sentence in one language and converting it to another language of the default of the user device thus it provides a user-friendly environment for foreign people.

8. As to dependent 2, Matsumoto, Hayashi, and Moughanni disclose specifying one of said pictographs of the displayed pictograph mixed sentence; determining a specific character string corresponding to said specific pictograph; and displaying said specific character string (Hayashi, page 1: Hayashi discloses an animation database stores the data of animation image about a character, retrieving a character that is inputted with a

conversion operation, then converting it into a corresponding candidate character into an animation image (pictograph mixed sentence) (Hayashi, page 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Hayashi and Matsumoto to include pictograph mixed sentence and the pictograph corresponding to said character string is defined since Hayashi provides a character converter which does not only simply perform character conversion but also has various conversion functions).

9. As to dependent claim 3, Matsumoto, Hayashi, and Moughanni disclose wherein said displaying includes: displaying said pictograph mixed sentence and said specific character string at a same time (Matsumoto, pages 1-2: Kanji/Kana mixed sentence is displayed; Hayashi discloses in page 1: retrieving a character that is inputted with a conversion operation, then converting it into a corresponding candidate character into an animation image (pictograph mixed sentence), and the motivation for combine Hayashi and Matsumoto is that Hayashi provides a character converter which does not only simply perform character conversion but also has various conversion functions).

10. As to dependent claim 4, Matsumoto, Hayashi, and Moughanni disclose inputting a sentence in a transmission mode; converting a specified one of character strings of said inputted sentence a specific pictograph corresponding to said specified character string, to produce a pictograph mixed inputted sentence; and displaying said pictograph mixed inputted sentence (Matsumoto, pages 1-2: a sentence is inputted for translation;

automatically converts each of character string to produce a mixed sentence; and displaying said mixed sentence (KANA/KANJI conversion is performed and the inputted sentence is turned to a KANJI/KANA mixed sentence, and the mixed sentence is displayed). However, Matsumoto does not disclose the mixed sentence is pictograph mixed sentence and the pictograph corresponding to said character string is defined. Hayashi discloses an animation database stores the data of animation image about a character, retrieving a character that is inputted with a conversion operation, then converting it into a corresponding candidate character into an animation image (pictograph mixed sentence) (Hayashi, page 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Hayashi and Matsumoto to include pictograph mixed sentence and the pictograph corresponding to said character string is defined since Hayashi provides a character converter which does not only simply perform character conversion but also has various conversion functions).

11. As to dependent claim 5, Matsumoto, Hayashi, and Moughanni disclose transmitting said pictograph mixed inputted sentence in said transmission mode (Matsumoto, pages 1-2; Hayashi discloses in page 1: retrieving a character that is inputted with a conversion operation, then converting it into a corresponding candidate character into an animation image (pictograph mixed sentence), and the motivation for combine Hayashi and Matsumoto is that Hayashi provides a character converter which

does not only simply perform character conversion but also has various conversion functions).

12. As to dependent claim 6, Matsumoto, Hayashi, and Moughanni disclose wherein said inputted sentence is a Kana sentence, said method further comprises: converting each of specified ones of Kana character strings of said inputted sentence into Kanji characters in said transmission mode (Matsumoto, page 1).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chau Nguyen whose telephone number is (571) 272-4092. The Examiner can normally be reached on Monday-Friday from 8:30 am to 5:30 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Heather Herndon, can be reached at (571) 272-4136.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. On July 15, 2005, the Central Facsimile (FAX) Number will change from 703-872-9306 to 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chau Nguyen
Patent Examiner
Art Unit 2176

William F Bashore

WILLIAM BASHORE
PRIMARY EXAMINER